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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 32

Application Number: 09/172,577
Filing Date: Oct 13, 1998
Appellant(s): Richard H. Hall et al.

Christopher J. Rudy
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed September 27, 2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 50, 61, and 68 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

3,617,580	Elizabeth et al.	11-1971
4,561,393	Kopel	12-1985
5,649,995	Gast, Jr.	7-1997
4,594,080	Tremain et al.	6-1986
JP 02082304 A	Fujiyama et al.	3-1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 16, 17, 19, 20, 39, 42, 43, 46, 47, and 51-53 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office action, Paper No. 23.

Claim 16 is rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office action, Paper No. 23.

Claims 16, 17, 39, and 50 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office action, Paper No. 23.

Claims 19, 20, 42, 43, 51-53, and 61 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office action, Paper No. 23.

Claims 46 and 47 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office action, Paper No. 23.

(11) Response to Argument

Arguments concerning claims 16, 17, 19, 20, 39, 42, 43, 46, 47, and 51-53 rejected under 35 U.S.C. 112, first paragraph.

1. The Examiner withdraws the new matter rejection concerning the limitation "without the presence of said inert gas blanket, the engine oil would present properties of needing to be changed after a few thousand miles of use in said internal combustion engine" as amended in

claims 20, 51, and 52. Therefore, the rejections of claims 20 and 51-53 under 35 U.S.C. 112, first paragraph is withdrawn.

2. In response to the appellant's argument concerning the new matter issue of "vented space" in claim 16, the Examiner respectfully disagrees. It appears that the appellant has expounded at great length (pages 4-8 of the Brief) to justify that the "vented space" in claim 16 is not a new matter since Fig. 1 of the present invention depicts an internal combustion engine and all of the internal combustion engines have a vent system. However, it is noted that the appellant has elected the invention I, the method of providing inert gas blanket to a machine having oleaginous liquid, as required under 35 U.S.C. 121 in Paper No. 2, and not the species as shown in Fig. 1. Furthermore, claim 16 does not include any recitation as to what exactly the "working machine" is. The "working machine" is best described in the Specification as originally filed, on page 2, under SUMMARY, as "fuel tanks, bearings, crankcases, gear boxes, transmissions, and so forth, employed in or in conjunction with internal combustion, jet and turbine engines." Therefore, the "working machine" as recited in claim 16 is broadly construed as any moving mechanical system that produces work in connection with internal combustion, jet and turbine engines, but not necessarily limiting the meaning of the "working machine" to the internal combustion engine alone as the appellant argues. By amending the limitation of the "working machine" with "vented space in a working machine" in claim 16, the appellant is implying that the fuel tanks, bearings, and gear boxes are vented as well. However, there is not a single disclosure which discusses the contemplation of vented system in those working machines in the specification as originally filed.

In order to conclude that the working machines, in general, have vents, it has to be known to any person of ordinary skill in the art that vents are **inherently** present in **all** of the working machines, and not just the internal combustion engines. (Note: the appellant has admitted on page 5, line 2 in the Brief, that the working machine is generic in terms) Albeit the references presented by the appellant, there are many working machines that are air tight as provided by the Examiner. For example, Wilde, U.S. Patent 2,623,186, shows an engine accessory for underwater operation, which requires the machine be air-tight without any vents to the ambient environment; Hetzel, U.S. Patent 3,792,578, teaches a transmission system which contains gears under vacuum chamber, which requires the machine be air-tight without any vents to the ambient environment; and Witt, U.S. Patent 4,414,861, discloses a gear box having a gear disposed in the enclosed housing without any vents. All of the above prior art are related to the "working machine". Furthermore, the disclosure on page 8, line 16, of the present invention, which states "Internal pressure relief opening and/or valve 60 may be provided", does not refer to the working machine, but to the silo in Fig. 4. The silo in Fig. 4 is not a "working machine". Also, the applicant elected the method claims, particularly in connection to the working machine. Therefore, one can not just combine a feature from the non-elected invention to the elected invention during the prosecution of the application without first disclosing in the specification as originally filed how such modification can be done. If the appellant continues to argue that the "working machine" is vented because the internal combustion engine is inherently vented, then why not change the limitation in claim 16 from the "working machine" to the "internal combustion engine". It appears

that the appellant is trying to claim as broadly as possible that includes all types of "working machine" and yet, justify the validity of the insertion of "vented space" by basing its argument with only one type of working machine, the internal combustion engine. The internal combustion engine does neither represent nor typifies the meaning of generic "working machine". In other words, just because the internal combustion engine inherently has a vent does not mean that all the working machines inherently have vents. Therefore, the limitation, "vented" in claim 16, is a new matter and the appellant is required to cancel the new matter.

3. In response to the appellant's argument that the "overpressure" disclosed in the specification contemplates a "vent", it is noted that the disclosure of "overpressure" disclosed on page 9, line 15 does not contemplate a "vent". The context in which the word "overpressure" is used states that "the invention may apply to any system in which a substantially enclosed space or a space to which an overpressure can be applied contains an oxidizable material." The above statement does not infer or suggest that there is a "vent" provided in order to reduce the overpressure. It simply states that the space can be applied with overpressure.

Arguments concerning claim 16 rejected under 35 U.S.C. 102(b) as anticipated by Kopel.

4. In response to the applicant's argument that Kopel does not describe the claimed invention in claim 16, it is the Examiner's contention that Kopel does describe the claimed invention as set forth in claim 16. Claim 16 recites the limitations concerning a working machine. Certainly, Kopel's sealed hydraulic lifter system is a working machine. Furthermore, the applicant argues

that claim 16 requires a vented system. As discussed above in paragraph 2, the "vented space" is a new matter because the space in a working machine that is vented is neither disclosed nor suggested in the specification as originally filed.

5. In response to the appellants argument that the Examiner had failed repeatedly to acknowledge the insertion of the limitation "vented space" until Paper No. 23, it is noted that the final Office action made on Jun 1, 2000, Paper No. 8, which is the immediate response to the Amendment filed Feb 14, 2000 and Feb 25, 2000, includes the rejection of claims 16, 17, 39, 42, 43, and 47 under 35 U.S.C. 112, first paragraph as containing subject matter, "vented space", which was not described in the specification as originally filed.

Arguments concerning the obviousness rejections under 25 U.S.C. 103(a).

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure,

such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The appellant has argued the hindsight reasoning without specifically connecting its argument to any specific prior art used in the rejections. Therefore, the Examiner will not respond in connection to any prior art in this paragraph. However, the specific response to the hindsight argument or nonanalogous argument concerning the specific prior art may be provided in the following paragraphs where it is appropriate.

Arguments concerning claims 16, 17, 39 and 50 rejections over Elizabeth et al. in view of Fujiyama et al.

7. In response to the appellant's argument that the "references, Elizabeth et al. and Fujiyama et al. are fundamentally unrelated to each other as well as to the claimed subject matter at issue", it is the Examiner's position that both references are related to each other as well as to the claimed subject matter at issue. In order for any references to be analogous, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992). In this case, Elizabeth et al. is in the field of appellants endeavor and reasonably pertinent to the particular problem which is to make the oil in working machine last longer in the field of lubrication for working machines. Elizabeth et al. discloses the field of endeavor by stating in the title "Lubricating Oil Treatment system" and in column 1, lines

5-10, "(the) present invention relates to a novel lubricating oil circulation system used in association with internal combustion engines and involves the circulation of mineral lubricating oil from the crankcase of an internal combustion engine through a filter and the returning of the filtered oil into the internal combustion engine for reuse therein." Furthermore, Elizabeth et al. discusses the particular problem wherein extending the life of the lubricating oil is important task as described in column 1, lines 32-62; wherein reducing the formation of degradation of the lubricating oil is examined from column 1, line 63 to column 2, line 16; and wherein prevention of the oxidation of fresh oil is disclosed in column 2, lines 17-49. The above description contemplates the problem in making the lubricating oil last longer. Thus, Elizabeth et al. tackles the problem by stating how to correct the problems facing the degradation of the oil from column 2, line 50 to column 3, line 57. Elizabeth et al. fails to show an inert gas blanket being provided in the working machine to control oxidative degradation of the oil. However, Elizabeth et al. clearly shows a method for controlling oxidative degradation of an oleaginous liquid substance in the working machine such as the engine. This assertion can be found, particularly in column 6, lines 41-45, where it describes the "increase in the resistance to oxidative degradation" for the control oil. Therefore, Elizabeth et al. is analogous and does not teach away from the present invention.

8. Concerning the modifying reference, Fujiyama et al., Fujiyama et al. teaches a method of providing inert gas blanket to control oxidative degradation of oil as described in the Abstract and Constitution. Fujiyama et al. is analogous because it is reasonably pertinent to the particular problem with which the applicant was concerned, that is to control the oxidative degradation of

oil. Fujiyama et al. teaches the method of preventing the oxidation of stored oil by purging the space above with inert gas. The inert gas does not necessarily contact the oil because no where in the claims recite such limitation. Since Fujiyama et al. shows that blanketing the oil with the inert gas would extend the life of the stored oil, it would have been obvious to a person of ordinary skill in the art to modify or add the oxidation treatment of Elizabeth et al. with the inert gas blanket method taught by Fujiyama et al. in order to provide a longer lasting system that controls oxidative degradation so that the cost of engine maintenance can be reduced.

9. The above response to the appellant's argument is not done in the sense of "out of context" by reading "just bits and pieces" of information from the references. As provided by the exact location of each descriptions in both references, the whole of the references is considered in making the obviousness rejections.

10. In response to the appellant's argument that the Examiner made a serious error by citing Oetiker decision to support the Examiner's position because it "was not the broad field of keeping elements from oxidizing...but rather is the pertinent field of keeping an oleaginous liquid, for example, an engine oil or a transmission fluid, from oxidizing", it is noted that Oetiker decision states that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. As discussed above in paragraph 7, Elizabeth et al. is both in the broad field of keeping elements from oxidizing and in the pertinent field of keeping an oleaginous liquid, for example, an engine oil from oxidizing. And

Fujiyama et al. is reasonably pertinent to the particular problem with which the applicant was concerned, that is teaching of providing an inert gas blanket to the oil to make the oil last longer.

Arguments concerning claims 19, 20, 42, 43, 51-53, and 61 rejections over Elizabeth et al. in view of Fujiyama et al. and further in view of Gast, Jr.

11. In response to the appellant's argument that Gast, Jr. is nonanalogous art, again, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2D 1443 (Fed. Cir. 1992). In this case, Gast, Jr. is reasonably pertinent to the particular problem, that is providing a membrane-containing device to separate nitrogen from air through a membrane as recited in claims 19, 42, 43, 53, and 61. Furthermore, whether Gast, Jr. is a static system or not, the nitrogen generating system of Gast Jr. provides a solution to the problem of separating nitrogen from air through a membrane.

12. In response to the appellant's argument that it is "egregious of the Examiners to attempt to apply Gast, Jr., which relates to a static system, and refuse to permit the Appellant to cite his own disclosure to an inert gas protected silo, also a static system", it is noted that the Appellant's responsibility and the Examiner's responsibility are not mutually carried out in exactly the same manner. It is the Appellant's duty to provide the specification that contains "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise,

and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention", as stated in 35 U.S.C. 112, first paragraph. And it is the Examiner's duty to make sure that a patent "may not be obtained though the invention is not identically disclosed or described as set forth in section 102...if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains", as stated in 35 U.S.C. 103(a). Therefore, the appellant cannot demand the same privilege that the Examiner has in making the patentability decisions.

13. In response to the appellant's argument that the engine can breakdown if driven at least 20,000, or even 50,000 miles without an oil change and that the Examiner had failed to provide any affidavit under 37 CFR 1.104(d)(2) for supporting the speculative dissenting views, it is the Examiner's position that some engines can last more than 50,000 miles without an oil change. Yes, there is a chance that an engine may experience a breakdown if proper maintenance is not performed as recommended by the factory. However, the "every 3,000 mile oil change" is not a must for every engine. It is only a recommendation by the manufacturers that if a normal petroleum based oil, such as SAE 10W30 or 10W40, is used, then the oil change should be done on the engine every 3,000 miles in order to maximize the performance of the engine. The manufacturers did not make any statements that the engine will breakdown at 3001 miles if the oil

change is not performed at 3000 miles. And there is no empirical data that shows exactly at which mileage all of the engines will breakdown if no oil change is performed. Every engine is different and the breakdown point is different for every engine. It is well known fact in the art of internal combustion engine that some may breakdown before they reach 3000 miles and some may last even beyond 50,000 miles without a single oil change. Therefore, the treated oil in Elizabeth et al. can last more than 50,000 miles before it is necessary to change the engine oil of the crankcase owing to the control of the oxidative degradation of the engine oil, as recited in claims 20, 51, and 52. As far as the affidavit is concerned, the Examiner does not believe that the affidavit is required to support the dissenting views. The appellant has not provided any empirical data on how he/she arrived at the engine running for 20,000 to 50,000 miles without an oil change. There is no solid evidence that the engine performance would last more than 20,000 miles if inert gas blanket is provided. The appellant simply states, in the Specification as originally filed, on page 3, lines 3-4, that "it may be necessary to change automobile engine oil only after twenty to fifty thousand miles of use or more." The Examiner is not going to dispute the information provided by the appellant if otherwise cannot disprove the fact. If the appellant provides sufficient evidence as to how he/she came up with the final number, then the Examiner has the burden to dispute, if there is any to dispute, with his own data to support his dissenting views. However, that is not the case in this scenario. If the appellant says that engine oil can last longer than 20,000 miles, then so be it. The Examiner has provided the prior art, Elizabeth et al., to reject that claim limitation.

Arguments concerning claims 46 and 47 rejections over Elizabeth et al. in view of Fujiyama et al. and further in view of Gast, Jr. and in view of Tremain et al.

14. In response to the appellant's argument that Tremain et al. is not properly applicable because it relates to delivery of Oxygen and not nitrogen, it is noted that the intent of utilizing Tremain et al. is to show the obviousness of providing oxygen to the passenger cabin space, as recited in claims 46 and 47, to make sure that the operator or passengers are kept from fainting or death when operating a machine. Elizabeth et al. in view of Fujiyama et al. and in view of Gast, Jr. teaches all the limitations, including the provision of nitrogen gas as recited in claims 16, 19, and 42, except the limitation that deals with providing oxygen to a passenger cabin space. Thus Tremain et al. provides such remedy by teaching that one of ordinary skill in the art may utilize the separated oxygen to be given to the passengers in a passenger cabin space.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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